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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/629,547    04/09/96    TAKAHASHI

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PM82/1029

EXAMINER
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FOLEY & LARDNER  
3000 K. STREET N.W.  
SUITE 500 P.O. BOX 25696  
WASHINGTON DC 20007-8696

LUONG, V ART UNIT	PAPER NUMBER
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3682  
DATE MAILED:

5)

10/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/629,547

Applicant(s)  
Takahashi et al.

Examiner  
Luong

Art Unit  
3682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/13/01
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 101-165 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 101-112 is/are allowed.
- 6) ☒ Claim(s) 113-165 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 5/20 & 7/23/97 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 07/485,659.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Vinh T. Luong  
Primary Examiner

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. The Amendment filed on August 13, 2001 (Paper No. 48) has been entered.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 20, 1997 and July 23, 1997 have been approved by the examiner.
3. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. The drawing correction must comply with 37 C.F.R. 1.121(b)(3), e.g., any change to the patent drawings (Figs. 1 and 3) must be by way of a new sheet of drawings with the amended figures identified as "amended."
4. Claims 113-165 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

It is well settled that a reissue application is not permitted to "recapture" claimed subject matter *deliberately* canceled in the original application. *In re Clement*, 45 U.S.P.Q. 1161 (CAFC

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1997). See M.P.E.P. 1412.02. Note also that in *Hester v. Stein, Inc.*, 46 U.S.P.Q.2d 1641 (CAFC 1998), the Court held that the recapture rule can be triggered by argument alone. Applicant *cannot* acquire, through reissue, claims that are the *same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection*.

Regarding claim 113, lines 1-12 of claim 113 are copied from in claim 16 of grand parent application Serial No. 07/485,659. However, claim 16 of SN'659 had been rejected by the examiner and affirmed by the Board of Appeal of the Office on January 5, 1994. On the other hand, the scope of the rest of claim 113 (lines 13-23) in this application is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since claim 16 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture old claim 16 of SN'659 by adding the limitation which is unrelated to the rejection based on Numata et al. as done in lines 13-23 of new claim 113.

Similarly, regarding claim 128, lines 1-11 of claim 128 are copied from claim 18 of SN'659. However, claim 18 of SN'659 had been rejected by the examiner and affirmed by the Board of Appeal of the Office on January 5, 1994. On the other hand, the scope of the rest of claim 128 in this application is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since old claim 18 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture it by adding the limitation unrelated to the rejection based on Numata et al. as seen in the rest of new claim 128.

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Regarding dependent claims 114-127 and 129-165, these dependent claims add further limitations to independent claim 113 or 128. The additional limitations are unrelated to the rejection in SN'659 based on Numata et al. Consequently, these dependent claims are also rejected under the recapture rule.

5. Claims 101-112 are allowed.

6. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

7. Applicant's arguments filed August 13, 2001 (Paper No. 48) have been fully considered but they are not persuasive.

#### **Objections to the Drawings & Specification**

The previous objections to the drawings and specification have been withdrawn in view of applicant's amendment.

#### **35 USC 251**

The rejection based on 35 USC 251 is withdrawn in view of applicant's cancellation of method claims.

#### **35 USC 251**

Applicant contended that new claims 113-165 are not subjected to recapture rule for the reasons set forth in the August 1, 2001 interview and in the amendments filed on December 3, 1999 and October 4, 2000.

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The examiner respectfully submits that applicant's arguments presented in the interview on August 1, 2001 and in the amendment filed on October 3, 2000 are related to the method claims 69-100. Applicant canceled these method claims in this amendment. Therefore, the previous arguments related to method claims are deemed to be moot. The only relevant arguments are the arguments presented in the amendment filed on December 3, 1999. For completeness, the examiner reiterated the response to applicant's arguments filed on December 3, 1999 set forth in the Office action on February 24, 2000 below:

The thrust of applicant's arguments is that the pending reissue claims 113 and 128 are broader in some aspects than claims 1 and 8 of U.S. Patent No. 5,465,635, however, these claims 113 and 128 are neither broader than nor essentially the same scope as the broadest claim canceled during prosecution of the original '635 patent.

The examiner does not dispute the fact that the pending reissue claims 113 and 128 are broader in some aspects than claims 1 and 8 of U.S. Patent No. 5,465,635. However, applicant's comparison of claims 113 and 128 with claims 1 and 8 of Pat.'635 is immaterial since claims 1 and 8 of Pat.'635 are allowed claims. The test is not whether the issue claims are broader in some respect in comparison to the patented claims. The test is *whether the claims 113 and 128 of this reissue application are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection in SN'659.*

In the instant case, claims 113 and 128 copy claims 16 and 18 of SN'659 and add new limitations in the "wherein" clauses. The first "wherein" clause which recites that "said elastic plate

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is clamped axially between said reinforcing member and said shaft end of said crankshaft” is copied from claim 4 of Pat.’635. The second “wherein” clause which recites that “said first portion of said flywheel body and said elastic plate defining a first clearance and said flywheel body having a first free space on a side opposite of the first clearance for allowing said first portion of said flywheel body to move axially within the first clearance and the free space” merely states inherent result of limitations already recited in the body of the claim, thus, it adds nothing to claim’s patentability or substance. *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018 (CAFC 1993). Since the added limitations are merely “*incidentally*” or “*inherent*,” they should not be considered as “material.” *Mentor Corporation v. Colorplast*, 998 F.2d 992 (CAFC 1993).

More important, a review of the prosecution history shows that claims 16 and 18 of SN’659 had been rejected by the examiner and affirmed by the Board decision on January 5, 1994. The copied part of the previously rejected claims *is the same in an aspect germane to a prior art rejection*. If applicant does not add any new limitation, the copied part of claims 113 and 128 should be automatically rejected under doctrine of *res judicata*. The new added limitations in claim 113 and 128 narrow the scope of the previously rejected claims 16 and 18 of SN’659, however, these new limitations are not only immaterial but also unrelated to the previous rejections of claims 16 and 18 of SN’659 based on Numata et al. (Japanese Patent Publication No. 57-058542).

Applicant averred, *inter alia*, that the added limitations “narrow the claims in any *material aspect* compared with their broadening,” then the reissue claim is broader in a way that does not attempt to reclaim what was surrendered.

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The examiner respectfully submits that applicant's contention is in direct conflict with the evidence presented in the record. In the case at hand, the added limitations do *not* "narrow the claims in any *material aspect* compared with their broadening" since the added limitations are already claimed in claim 4 of Pat.'635. Claim 4 of Pat.'635 was allowed because it was dependent upon claim 1 of Pat.'635. It can be determined from the patented file that the examiner and/or the Board considered the limitations set forth in the "wherein" clause of claims 1, 8 and 9 of original application as defining over the prior art, i.e., making the original claims 1, 8 and 9 allowable, *a fortiori*, these limitations must be recited in the reissue claims in order to avoid the recapture rule.

Pursuant to the guidelines on page 4 of the Memorandum of the Office about Recapture Rule to Reissue Applications dated September 21, 1999, the narrow scope of the claims 1, 8 and 9 in the Pat.'635 is not an error within the meaning of 35 U.S.C. 251. Therefore, the broader scope surrendered in the application SN'659 for the Pat.'635 cannot be recaptured by the filing of the present reissue application. This rule has been recently reiterated by the Court in *Pannu v. Storz Instruments Inc.*, 59 U.S.P.Q.2d 1597 (CAFC 7/2/5/01). The facts in this case are similar to the facts in *Pannu* wherein the examiner rejected claims 1-14 as obvious during the prosecution of patent, in response to the rejection, *Pannu* filed a supplemental amendment canceling claim 1 and adding new independent claim 16. In the instant case, applicant similarly canceled claims 16 and 18 in response to the rejection of the examiner and the Board, and filed new claims 113 and 128 in reissue application. The rejection based on 35 USC 251 is proper since applicant's reissue application improperly broadens the claims in a manner directly pertinent to subject matter surrendered during



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prosecution and reissue claims 113 and 128 are not materially narrowed with respect to broadened aspects as analyzed by the CAFC in *Pannu*.

For the reasons set forth above, the rejection based on recapture rule is maintained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 7:30 AM EST to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

October 26, 2001



Vinh T. Luong  
Primary Examiner